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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,049	03/30/2001	Keisei Yamamuro	2001-0375A	5127
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WENDEROTH, LIND & PONACK, L.L.P. 2033 K STREET N. W. SUITE 800 WASHINGTON, DC 20006-1021			FISH, JAMIESON W	
			ART UNIT	PAPER NUMBER
			2616	

DATE MAILED: 03/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/821,049

Applicant(s)

YAMAMURO ET AL.

Examiner

Jamieson W. Fish

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statements (IDS) filed on 1/29/03 and 3/21/02 have been considered by the examiner.

### ***Specification***

2. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: The term "CM" on page 2, line 18 and page 17, line 13 is not clearly defined. The specification also includes various typos throughout.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims **1-16, 28** are rejected under 35 U.S.C. 102(b) as being anticipated by Sumiya et al. (EP 0 892 554).
5. Regarding claim 1, Sumiya teaches a receiver comprising: a program acceptor for accepting program contents, and program information having a program identifier to identify program contents (See Fig. 2, Broadcast Reception Unit 201 Fig. 4 Program ID

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Field 410, Col. 14 lines 2-13, Col. 15 lines 40-58, Col. 16 lines 1-2); display unit for displaying the program contents (See Fig. 38 Display Unit 3804 and Col. 42 lines 49-58, Col. 43 lines 1-5); and viewing information recorder for recording viewing information having the program identifier to identify the program contents on a removable recording medium, when program contents are displayed on the display unit (See Fig. 38 Viewing History Hold Unit 3808, Fig. 41, Fig. 42, Fig. 102, Col. 42 lines 49-58, Col. 43 lines 1-18, Col. 79 lines 35-43 Viewing history is are stored on a removable memory).

6. Regarding claim 2, Sumiya teaches the receiver further comprising: a display attribute acquisition unit for obtaining a display attribute that is an attribute by which the program contents are displayed (Fig. 2 Display Control Unit 203 Col. 17 lines 30-46); wherein the viewing information has the display attribute and the program identifier (See Fig. 3, Fig. 4 Col. 13 lines 45-58, Col. 14 lines 1-35).

7. Regarding claim 3, Sumiya teaches wherein the display attribute is the position where the program contents are displayed (See Fig. 3 Image Data Field and Col. 13 lines 45-57 Moving picture data would include position where program contents are displayed).

8. Regarding claim 4, Sumiya teaches wherein the viewing information further includes the number of viewing times, which is the number of times a user has viewed the program contents (See Fig. 42 Frequency and Col. 44 lines 44-51).

9. Regarding claim 5, Sumiya teaches an input acceptor for accepting a user input (See Fig. 38 Input Unit 3805 and Col. 44 lines 7-11); wherein, when program contents are displayed on the display unit on the basis of the user input accepted by input

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acceptor, the viewing information recorder records viewing information on the removable recording medium (See Col. 44 lines 12-44).

10. Regarding claim 6, Sumiya teaches wherein, when the input acceptor accepts the user input for a predetermined period of time, the viewing information recorder records the viewing information on the removable recording medium (See Col. 44 lines 7-44 When the user selects a program (pushes a button for a predetermined amount of time) the program information is added to viewer history).

11. Regarding claim 7, Sumiya teaches wherein: the input acceptor accepts an input of information related to the program (See Fig. 38 Input Unit 3805 Col. 44 lines 7-44 Input selecting program is an input related to the program); and when the input acceptor accepts the related information, the viewing information recorder records viewing information on the removable recording medium (See Col. 44 lines 32-43 When user selects program, attributes are saved).

12. Regarding claims 8-14, claims 8-14 are method claims related to the apparatus of claims 1-7, respectively. Therefore claims 8-14 are analyzed and rejected according to claims 1-7.

13. Regarding claim 15, claim 15 is a computer-readable program medium on which a program making a computer execute the method of claim 8 is stored. Sumiya teaches wherein the method is executed by a program on a computer-readable medium (See Fig. 2 Control Unit 212).

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14. Regarding claim 16, Sumiya teaches a removable recording medium on which viewing information is recorded by the viewing information method of claim 8 (See Fig. 102, Col. 79 lines 35-43).

15. Regarding claim 28, Sumiya teaches a recording medium having an information identifier and a frequency (See Fig. 38 Viewing History Hold Unit 3808, Fig. 42 and Col. 44 lines 52-56).

16. Claims 17, 29-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Nemirofsky (US 5,594,493).

17. Regarding claim 17, Nemirofsky teaches a service contents decision method for decoding service contents on the basis of viewing information recorded on removable recording medium (See Col. 1 lines 14-24, Col. 3 lines 49-63, Col. 5 lines 39-50, Col. 11 lines 42-67, Col. 12 lines 1-17 Scanning a bar code decodes service contents based on recorded viewing information and decides if information is in store computer).

18. Regarding claim 29, Nemirofsky teaches a transmitter/receiver system comprising: a transmitter for transmitting program contents and a right identifier corresponding to the program contents (See Fig. 1 Television Station 5, Col. 3 lines 40-63, Col. 7 line 25-48 Right identifier is signal data code sent with advertisement); a receiver for receiving the program contents and a right identifier transmitted from the transmitter, and recording the right identifier on a removable recording medium (See Fig. 1 Receiver 3 Col. 3 lines 40-67, Col. 4 lines 1-6, Col. 7 lines 25-48 Smart card is a removable recording medium that records data signal); and an information terminal for reading the right identifier recorded on the removable recording medium, and

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performing a process corresponding to the right identifier (See Fig. 1 Bar Code Reader 7, Col. 1 lines 25-48, Col. 3 lines 40-67, Col. 4 lines 1-6 Bar code reader reads data and user receives appropriate discount); wherein said receiver comprises: a program acceptor for accepting the program contents and the right identifier (See Col. 3 lines 40-67, Col. 4 lines 1-6, Col. 7 lines 25-50 Since receiver receives (accepts) program contents and right identifier, program acceptor is inherent); a display unit for displaying the program contents (See Fig. 1 Display Unit 3 and Col. 7 lines 25-48); and a viewing information recorder for recording the right identifier corresponding to the program contents on the removable recording medium, when the program contents are displayed on the display unit (See Fig. 1 Smart Card 1 and Col. 7 lines 25-61).

19. Regarding claim **30**, Nemirofsky teaches wherein the transmitter transmits the program contents and the right identifier on broadcast waves (See Fig. 1 Broadcast Signal 2 Col. 3 lines 57-63, Col. 7 lines 25-48).

20. Regarding claim **31**, Nemirofsky teaches wherein the transmitter transmits the program contents and the right identifier through a communication network (See Fig. 1 Broadcast Signal 2 Col. 3 lines 57-63, Col. 7 lines 25-48 A television broadcast transmitted through a communication network).

21. Claims **18-19, 29, 32** are rejected under 35 U.S.C. 102(b) as being anticipated by Shintani (EP 0 921 696).

22. Regarding claim **18**, Shintani teaches a viewing information processor (See Fig. 1 Microprocessor 8 and Paragraph 16) for reading viewing information recorded on removable recording medium (See Fig. 1 Smart Card 10 and Paragraph 44), and

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processing the viewing information, comprising: a viewing information acquisition unit for reading the viewing information (See Fig. 2 S9 and Paragraphs 24, 28 and 29 Viewing information is number of points); a service information holding unit for holding service contents in association with a provision condition that is a condition to provide a service specified by the service contents (See Paragraphs 28 and 29. Service is discounted pay broadcasting. Provisional condition is number of points needed for discount pay for broadcast); a service contents decision unit for deciding the service contents, by applying the provision condition held by the service information holding unit to the viewing information obtained by the viewing information acquisition unit (See Fig. 2 S13 Paragraphs 24 and 30. Decision is made as to if user has enough points to get pay broadcasting for a discount. Points are obtained by viewing information); and a service contents output unit for outputting the service contents decided by the service contents decision unit (See Paragraphs 30 and 31 Discounted Pay Broadcasting is output if there are enough points).

23. Regarding claim **19**, Shintani teaches the viewing information processor further comprising a viewing information deletion unit for deleting the viewing information recorded on the recording medium, when the service contents output unit outputs the service contents (See Paragraph 29 Points are subtracted).

24. Regarding claim **29**, Shintani teaches a transmitter/receiver system comprising: a transmitter for transmitting program contents and a right identifier corresponding to the program contents (See Fig. 2 S2, S3, Paragraph 13, Paragraph 22-25, Receiver receives a program and a right identifier (Points rewarded and commercial ID are right



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identifier). Transmitter is inherent); a receiver for receiving the program contents and a right identifier transmitted from the transmitter, and recording the right identifier on a removable recording medium (See Fig. 1, Fig. 2, S2, S3, Paragraph 13, Paragraph 22-25 ID and points are recorded on the smart card); and an information terminal for reading the right identifier recorded on the removable recording medium, and performing a process corresponding to the right identifier (See Paragraph 44-50 Contents of smart card including commercial ID and points associated with ID are read at a terminal. Terminal then analyzes the IDs and number of points rewarded. Viewer receives a discount if enough points have been earned); wherein said receiver comprises: a program acceptor for accepting the program contents and the right identifier (See Fig. 1 Tuner 2 and Paragraph 13); a display unit for displaying the program contents (See Fig. 1 Display 7A and Paragraph 14); and a viewing information recorder for recording the right identifier corresponding to the program contents on the removable recording medium, when the program contents are displayed on the display unit (See Fig. 1 Smart Card 10 and Paragraph 22).

25. Regarding claim **32**, Shintani teaches wherein the information terminal comprises: an identifier acquisition unit for reading the right identifier recorded on the removable recording medium (See Fig. 2 S9 and Paragraphs 24, 25, 28 and 29 Points rewarded are right identifier); a service information holding unit for holding service contents in association with a provision condition that is a condition to provide a service decided by the service contents (See Paragraphs 28 and 29. Service is discounted pay broadcasting. Provisional condition is number of points needed for discount pay for

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broadcast); a service contents decision unit for deciding the service contents, by applying the provision condition held by the service information holding unit to the right identifier obtained by the identifier acquisition unit (See Fig. 2 S13 Paragraphs 24 and 30. Decision is made as to if user has enough points to get pay broadcasting for a discount. Points are obtained by viewing information); and a service contents output unit outputting the service contents decided the service contents decision unit (See Paragraphs 30 and 31 Pay Broadcasting output at a discount if there are enough points).

26. Claims **20-21, 23-24, and 26-27** are rejected under 35 U.S.C. 102(b) as being anticipated by Roberts et al. (US 5,987,525).

27. Regarding claim **20**, Roberts teaches an information acquisition apparatus for obtaining information from an information server which manages the information (See Fig. 1 User's computer and server), comprising: an acquisition information reader for reading acquisition information, which indicates that information is to be obtained, from a removable recording media on which the acquisition information is recorded (See Fig. 1 CD player, Col. 6 lines 23-30 CD drive reads CD identifier); and an information acquisition unit for obtaining the information from the information server when the acquisition information reader obtains the acquisition information (See Fig.1 Browser Col. 6 lines 15-42 Browser receives web content associated with CD).

28. Regarding claim **21**, Roberts teaches an information acquisition apparatus for obtaining information from an information server which manages the information in association with an information identifier to identify the information (See Fig. 1 User's

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computer and server), a comprising: an acquisition information reader for reading acquisition information having an information identifier, from a removable recording media on which the acquisition information is recorded (See Fig. 1 CD player, Col. 6 lines 23-30 CD drive reads CD identifier); and an information acquisition unit for obtaining, from the information server, the information identified by the information identifier included in the acquisition information (See Fig. 1 Browser Col. 6 lines 15-42 Browser receives web content associated with CD).

29. Regarding claims **23** and **24**, claims **23** and **24** are method claims related to the apparatus of claims 20 and 21, respectively. Therefore claims **23** and **24** are analyzed and rejected according to claims 20 and 21.

30. Regarding claim **26**, claim 26 is a computer-readable program medium on which a program making a computer execute the method of claim 23 is stored. Roberts teaches where his method is executed by a program stored on a computer-readable medium (See Col. 2 lines 65-67 and Col. 3 lines 1-60)

31. Regarding claim **27**, Roberts teaches a recording medium to be mounted on the information acquisition apparatus of Claim 20 (See Col. 6 lines 15-42 CD).

### ***Claim Rejections - 35 USC § 103***

32. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

33. Claims **22** and **25** are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts in view of Nemirofsky.

34. Regarding claim **22**, Roberts differs from the claimed invention in that the user does not necessarily have a limited number of times in which he can access information from the server. Nemirofsky teaches wherein the access information also includes a frequency indicating the number times user can obtain the information (See Col. 6 lines 61-63 Stored product data is access information); the apparatus further comprises a frequency decrement unit for decrementing the frequency when the information acquisition unit obtains the information (See Col. 6 lines 61-63 Frequency decrement unit is inherent); and when the frequency is 1 or more, the information acquisition obtains the information (See Col. 6 lines 61-63). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Roberts so that user had a predetermined number of time to access information as taught by Nemirofsky to insure companies providing a benefit to consumers could better meet their objective (increasing profits) (See Nemirofsky Col. 1 lines 25-41).

35. Regarding claim **25**, claim **25** is a method claim related to the apparatus of claims 22. Therefore claims **25** is analyzed and rejected according to claims 22.

36. Claims **33-34** are rejected under 35 U.S.C. 103(a) as being unpatentable over Nemirofsky in view of Roberts.

37. Regarding claim **33**, Nemirofsky differs from the claimed invention in that his information terminal does not necessarily receive information from an information server when the right identifier is read. However, obtaining information corresponding to a

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right identifier from an information server when data is read at an information terminal is well known in the art. Roberts teaches an information server which holds information in association with the right identifier transmitted from the transmitter and, on receipt of the right identifier from the information terminal, transmits the information corresponding to the right identifier to the information terminal (See Col. 6 lines 23-42); wherein said information terminal transmits the right identifier read from the removable recording medium to the information server, and receives the information corresponding the transmitted right identifier from the information server (See Col. 6 lines 23-42).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Nemirofsky's information terminal so that it obtained information corresponding to an identifier from an information server when the identifier was read as taught by Roberts to allow the information terminal to access information as it needed and thus making it unnecessary for the information terminal to store information corresponding to every identifier locally, thereby freeing up memory for other applications.

38. Regarding claim **34**, Nemirofsky and Roberts teach wherein the information terminal comprises: an identifier reader for reading a right identifier from a removable recording medium on which the right identifier is recorded (See Roberts Fig. 1 CD player, Col. 6 lines 23-30 CD drive reads CD identifier); and an information acquisition unit for transmitting the right identifier to the information server when the identifier reader reads the right identifier to obtain information from the information server (See

Fig. 1 Browser Col. 6 lines 15-42 Browser transmits identifier to server and receives web content associated with CD).


***Conclusion***

39. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamieson W. Fish whose telephone number is 571-272-7307. The examiner can normally be reached on Monday-Friday, 8:00-5:30.

40. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ngoc Vu can be reached on 571-272-7320. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

41. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JF 2/14/2005

  
NGOC YEN VU  
PRIMARY EXAMINER